

Remarks

Claims 1, 2, 3, 5, 7 through 25, 27 and 29 through 43 and 45 through 61 remain pending in the application. Claims 1, 2, 24, 38 and 49 are amended.

Claims 38 and 49 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claims 38 and 49 are amended to recite that the open portion contains "a subset of minutiae data selected such that the content of the open portion is insufficient to construct a fake template that would allow an impostor to be incorrectly authenticated as a genuine user." This is supported in the original disclosure at page 16, in the second full paragraph from the bottom of the page ("Since the remote computation (i.e. at the client terminal 2) is only used to align the two sets of minutiae, does not have even the full minutiae information of the maximum nine minutiae for alignment and does not affect the actual global matching process itself, thus the proposed distributed processing will not compromise the security of the fingerprint matching in any way"). Further support can be found at page 15, first paragraph ("[t]he local stage uses a subset of fingerprint minutiae (which is the open portion mentioned earlier)"), and at page 8, first paragraph ("the open portion of the template which is transmitted is not enough to construct a fake template to gain access of the smart card"). That this process can be performed using the distributed computing method of claims 38 and 49 is supported from page 34, last paragraph to page 36 second-to-last paragraph, which support using the algorithms described earlier in the specification using a distributed computing method such

as is claimed in claims 38 and 49. This rejection should be withdrawn.

Claims 1, 2, 3, 5, 7 through 25, 27 and 29 through 37 stand rejected under 35 U.S.C. § 102(e) as anticipated by Hamid, Method and Apparatus for Hashing Data, U.S. Patent 7,274,804 (Sep. 25, 2007). Hamid is not prior art under 35 USC 102(e) in its entirety. Hamid has a filing date in the U.S. of April 14, 2003. The effective U.S. filing date of the present application is the same as its international filing date – August 8, 2002, since the U.S. was designated in the PCT filing. See MPEP 1893.03(b), 35 USC 363. Therefore, the effective U.S. filing date, and the invention date of the present application pre-dates the filing date of Hamid.

While Hamid itself was not filed before the effective U.S. filing date of the present application, Hamid is a continuation-in-part of an earlier application – U.S. Application No. 10/157,120, filed on May 30, 2002. Therefore, portions of Hamid may be considered 102(e) prior art, but only with respect to the material disclosed in the earlier application. See MPEP 706.02(VI)(B). Portions of Hamid that are not fully supported in the earlier application are not usable as prior art against the present application.

The earlier application 10/157,120, now issued to Hillhouse et al., Method and Apparatus for Supporting a Biometric Registration Performed on a Card, U.S. Patent 7,274,807 (Sep. 25, 2007) (Hereinafter Hillhouse), does not include a public or open portion. In particular, the various embodiments of Hillhouse either do not involve sending biometric data from the smart card (see, e.g., the embodiments of Figs. 3, 10, 11, and

12 – described as not sending biometric information at Hillhouse col. 6, ll. 55-59, col. 12, ll. 61-64, col. 13, ll. 49-52, and col. 14, ll. 53-56, respectively), or do not have a "public portion" (i.e., an open portion – see, e.g., embodiments of Figs. 6, 7, 8, and 9 – described as not providing data in the form of a public portion of a template at Hillhouse col. 9, ll. 18-24, col. 10, l. 19-25, col. 11, ll. 4-10, and col. 11, line 65 through col. 12, line 4, respectively). With respect to not sending a "public portion" of a biometric template (i.e., an open portion), Hillhouse states throughout its description that "biometric data in the form of a public portion of a template is not provided to a preprocessor, for instance a processor of a host system, from the smart card" (see, e.g., Hillhouse, col. 9, ll. 18-24 – emphasis added). Not sending a public portion is done to provide a process that is "alterable without suffering the drawbacks of the prior art methods" (Hillhouse, col. 9, ll. 18-24).

Note that although some embodiments of Hillhouse – e.g., the embodiment of Fig 5, send information related to biometrics (e.g. minutia locations) from the smart card to the host system for use in e.g. alignment, biometric information is not divided into a public or open portion and a private portion as described and claimed in the present application. Instead, after a PIN is provided, the smart card retrieves limited information from a single template associated with the PIN (i.e., a private template), which is then sent to the host system (see, e.g., Hillhouse, col. 8, l. 31-61). There is no indication that the stored template information is divided into an open portion and a private portion, such as is described and claimed in the present application.

Each of the independent claims of the present application includes a limitation of using an "open portion" of a "biometric identification template". As discussed above, Hillhouse specifically indicates that its embodiments do not use a "public portion" or (in the case of some embodiments) send biometric information. Accordingly, the present application is believed to be patentable over Hillhouse.

Additionally, since the hashed public portion discussed in Hamid is not present in Hillhouse, it would not be entitled to the earlier date of Hillhouse, but only to the later filing date of Hamid. Accordingly, it would not be prior art under 35 USC 102(e) or 103(a).

Further, Applicants submit herewith a declaration under 37 C.F.R. 1.131, showing that their invention predates the filing date of Hillhouse. Accordingly, even Hillhouse (of which the cited Hamid reference is a CIP) is not prior art under 35 USC 102(e). Thus, neither Hamid nor its parent, Hillhouse, are available for use as prior art in rejecting the claims of the present application. Accordingly, applicants respectfully request that the rejections of claims 1, 2, 3, 5, 7 through 25, 27 and 29 through 37 be withdrawn.

Claims 38 through 43 and 45 through 61 stand rejected under 35 USC 103(b) as anticipated by Studd, Method and System for Executing Applications on a Mobile Device, U.S. Patent Application Publication 2004/0122774 (Jun. 24, 2004).

As discussed above, Hamid is not available as prior art under 35 USC 103(b) and Studd does not anticipate the claimed invention. The rejection of claims 38 through 43 and 45 through 61 should be withdrawn as discussed above.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

Date: February 18, 2010

By: /Paul J. Backofen/

Paul J. Backofen, Esq.

Reg. No. 42278